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|   |   |   |
|---|---|---|
| <b>TRANSMITTAL LETTER TO THE UNITED STATES<br/>DESIGNATED/ELECTED OFFICE (DO/EO/US)<br/>CONCERNING A SUBMISSION UNDER 35 U.S.C. 371</b>   |   | ATTORNEY'S DOCKET NUMBER<br>514572001900                      |
| INTERNATIONAL APPLICATION NO.<br>PCT/CN2003/000666  | INTERNATIONAL FILING DATE<br>13 August 2003 | U.S. APPLICATION NO. (if known, see 37 CFR 1.5)<br>10/567,535 |
| TITLE OF INVENTION<br>FLUORESCENT MAGNETIC NANOPARTICLES AND PROCESS OF PREPARATION   |   | PRIORITY DATE CLAIMED<br>8 August 2003                        |
| APPLICANT(S) FOR DO/EO/US<br>Huachang LU et al.   |   |   |
| Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:   |   |   |
| 1. <input type="checkbox"/> This is a <b>FIRST</b> submission of items concerning a submission under 35 U.S.C. 371.   |   |   |
| 2. <input checked="" type="checkbox"/> This is a <b>SECOND</b> or <b>SUBSEQUENT</b> submission of items concerning a submission under 35 U.S.C. 371.  |   |   |
| 3. <input type="checkbox"/> This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below. |   |   |
| 4. <input type="checkbox"/> The US has been elected (Article 31).   |   |   |
| 5. <input type="checkbox"/> A copy of the International Application as filed (35 U.S.C. 371 (c)(2))   |   |   |
| a. <input type="checkbox"/> is attached hereto (required only if not communicated by the International Bureau).   |   |   |
| b. <input type="checkbox"/> has been communicated by the International Bureau.  |   |   |
| c. <input type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US).  |   |   |
| 6. <input type="checkbox"/> An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).  |   |   |
| a. <input type="checkbox"/> is attached hereto.   |   |   |
| b. <input type="checkbox"/> has been previously submitted under 35 U.S.C. 154(d)(4).  |   |   |
| 7. <input type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))  |   |   |
| a. <input type="checkbox"/> are attached hereto (required only if not communicated by the International Bureau).  |   |   |
| b. <input type="checkbox"/> have been communicated by the International Bureau.   |   |   |
| c. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired.   |   |   |
| d. <input type="checkbox"/> have not been made and will not be made.  |   |   |
| 8. <input type="checkbox"/> An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).   |   |   |
| 9. <input type="checkbox"/> An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).  |   |   |
| 10. <input type="checkbox"/> An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).                   |   |   |
| <b>Items 11 to 20 below concern document(s) or information included:</b>  |   |   |
| 11. <input checked="" type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98. (3 pages)   |   |   |
| 12. <input type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.  |   |   |
| 13. <input type="checkbox"/> A preliminary amendment.   |   |   |
| 14. <input type="checkbox"/> An Application Data Sheet under 37 CFR 1.76.   |   |   |
| 15. <input type="checkbox"/> A substitute specification.  |   |   |
| 16. <input type="checkbox"/> A power of attorney and/or change of address letter.   |   |   |
| 17. <input type="checkbox"/> A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 – 1.825.   |   |   |
| 18. <input type="checkbox"/> A second copy of the published International Application under 35 U.S.C. 154(d)(4).  |   |   |
| 19. <input type="checkbox"/> A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).  |   |   |

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|   |   |   |                     |
|---|---|---|---------------------|
| U.S. APPLICATION NO. (if known, see 37 CFR 1.5)<br><b>10/567,535</b>  | INTERNATIONAL APPLICATION NO.<br><b>PCT/CN2003/000666</b> | ATTORNEY'S DOCKET NUMBER<br><b>514572001900</b>                               |                     |
| 20. <input checked="" type="checkbox"/> Other items or information: PTO/SB/08a/b Form (1 page plus duplicate)<br>References (6)<br>Return Receipt Postcard  |   |   |                     |
| The following fees have been submitted  |   | <b>CALCULATIONS</b>   | <b>PTO USE ONLY</b> |
| 21. <input type="checkbox"/> Basic national fee (37 CFR 1.492(a)) ..... \$300   |   | \$  |                     |
| 22. <input type="checkbox"/> Examination fee (37 CFR 1.492(c))<br>If the written opinion of the ISA/US or the international preliminary examination report prepared by IPEA/US indicates all claims satisfy provisions of PCT Article 33(1)-(4) ..... \$0<br>All other situations ..... \$200   |   | \$  |                     |
| 23. <input type="checkbox"/> Search fee (37 CFR 1.492(b))<br>If the written opinion of the ISA/US or the international preliminary examination report prepared by IPEA/US indicates all claims satisfy provisions of PCT Article 33(1)-(4) ..... \$0<br>Search fee (37 CFR 1.445(a)(2)) has been paid on the international application to the USPTO as an International Searching Authority ..... \$100<br>International Search Report prepared by an ISA other than the US and provided to the Office or previously communicated to the US by the IB ..... \$400<br>All other situations ..... \$500 |   | \$  |                     |
| <b>TOTAL OF 21, 22 and 23 =</b>   |   | \$ 0.00   |                     |
| <input type="checkbox"/> Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing in compliance with 37 CFR 1.821(c) or (e) or computer program listing in an electronic medium) (37 CFR 1.492(j)).<br>The fee is \$250 for each additional 50 sheets of paper or fraction thereof.   |   |   |                     |
| Total Sheets  | Extra Sheets  | Number of each additional 50 or fraction thereof (round up to a whole number) | RATE                |
| - 100 =   | /50 =   |   | x \$250.00          |
|   |   |   | \$                  |
| Surcharge of \$130 for furnishing any of the search fee, examination fee, or the oath or declaration after the date of commencement of the national stage (37 CFR 1.492(h)).  |   | \$  |                     |
| CLAIMS  | NUMBER FILED  | NUMBER EXTRA  | RATE                |
| Total claims  | - 20 =  |   | x                   |
| Independent claims  | - 3 =   |   | x                   |
| MULTIPLE DEPENDENT CLAIM(S) (if applicable)   |   |   | +                   |
| <b>TOTAL OF ABOVE CALCULATIONS =</b>  |   | \$ 0.00   |                     |
| <input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Fees above are reduced by 1/2.   |   | 0.00  |                     |
| <b>SUBTOTAL =</b>   |   | \$ 0.00   |                     |
| Processing fee of \$130.00 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 CFR 1.492(i)).   |   | \$  |                     |
| <b>TOTAL NATIONAL FEE =</b>   |   | \$ 0.00   |                     |
| Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property  |   | \$  |                     |
| <b>TOTAL FEES ENCLOSED =</b>  |   | \$ 0.00   |                     |
|   |   | Amount to be refunded:  | \$                  |
|   |   | Amount to be charged  | \$                  |

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- a. ☐ A check in the amount of \$ \_\_\_\_\_ to cover the above fees is enclosed.
- b. ☐ Please charge my Deposit Account No. \_\_\_\_\_ in the amount of \$ 0.00 to cover the above fees.  
A duplicate copy of this sheet is enclosed.
- c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 03-1952. A duplicate copy of this sheet is enclosed.
- d. ☐ Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. **Credit card information should not be included on this form.** Provide credit card information and authorization on PTO-2038

**NOTE:** Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status.

SEND ALL CORRESPONDENCE TO:

Peng Chen  
Morrison & Foerster LLP  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040

  
SIGNATURE

Peng Chen  
NAME

CUSTOMER NUMBER: 25225

43,543  
REGISTRATION NUMBER

U.S. APPLICATION NO. (if known, see 37 CFR 1.5)  
10/567,535

INTERNATIONAL APPLICATION NO.  
PCT/CN2003/000666

ATTORNEY'S DOCKET NUMBER  
514572001900

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: February 28, 2006

Signature:  (Lenay Rogus)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: February 28, 2006

Signature:   
(Leray Rogus)

Patent  
Docket No. 514572001900

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Huachang LU et al.

Serial No.: 10/567,535

Filing Date (Int'l): August 13, 2003

For: FLUORESCENT MAGNETIC  
NANOPARTICLES AND PROCESS OF  
PREPARATION

Examiner: Not Yet Assigned

Group Art Unit: Not Yet Assigned

### INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98

MS PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. §1.97 and § 1.98, Applicants submit for consideration in the above-identified application the documents listed on the attached Form PTO/SB/08a/b. Copies of foreign documents and non-patent literature are submitted herewith. The Examiner is requested to make these documents of record.

The document numbers 5, 6, 7, and 8, listed on the attached Form PTO/SB/08a/b were cited in an International Search Report mailed on October 10, 2003, directed to a counterpart international or foreign application and have not been previously cited.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
  - ☐ A fee is required. A check in the amount of \_\_ is enclosed.
  - ☐ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of \_\_ is enclosed.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist;

(iii) the information, protocols, results and the like reported by third parties are accurate or enabling;  
or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 514572001900.

Dated: February 26, 2006

Respectfully submitted,

By 

Peng Chen

Registration No.: 43,543

MORRISON & FOERSTER LLP

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(858) 720-5117

|  |   |    |   |                          |                         |
|--|---|----|---|--------------------------|-------------------------|
| Substitute for form 1449/PTO<br><br><b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br><i>(Use as many sheets as necessary)</i> |   |    |   | <b>Complete if Known</b> |                         |
|  |   |    |   | Application Number       | 10/567,535              |
|  |   |    |   | Filing Date              | (Int'l) August 13, 2003 |
|  |   |    |   | First Named Inventor     | Huachang LU             |
|  |   |    |   | Art Unit                 | Not Yet Assigned        |
|  |   |    |   | Examiner Name            | Not Yet Assigned        |
| Sheet  | 1 | of | 1 | Attorney Docket Number   | 514572001900            |

| U.S. PATENT DOCUMENTS |                          |  |                                   |  |   |
|-----------------------|--------------------------|--|-----------------------------------|--|---|
| Examiner<br>Initials* | Cite<br>No. <sup>1</sup> | Document Number                          | Publication<br>Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited Document | Pages, Columns, Lines, Where<br>Relevant Passages or Relevant<br>Figures Appear |
|                       |                          | Number-Kind Code <sup>2</sup> (if known) |                                   |  |   |
|                       | 1.                       | US-4,554,088                             | 11-19-1985                        | Whitehead et al.                                   |   |
|                       | 2.                       | US-4,628,037                             | 12-09-1986                        | Chagnon et al.                                     |   |
|                       | 3.                       | US-4,672,040                             | 06-09-1987                        | Josephson  |   |
|                       | 4.                       | US-6,013,531                             | 01-11-2000                        | Wang et al.  |   |
|                       | 5.                       | US-2002/0164271-A1                       | 11-07-2002                        | Ho   |   |

| FOREIGN PATENT DOCUMENTS |                          |   |                                   |  |   |                |
|--------------------------|--------------------------|---|-----------------------------------|--|---|----------------|
| Examiner<br>Initials*    | Cite<br>No. <sup>1</sup> | Foreign Patent Document   | Publication<br>Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited Document | Pages, Columns, Lines,<br>Where Relevant Passages or Relevant<br>Figures Appear | T <sup>6</sup> |
|                          |                          | Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known) |                                   |  |   |                |
|                          | 6.                       | CN-1347958  | 05-08-2002                        | Guangshun Yi et al.                                |   |                |
|                          | 7.                       | CN-1376759  | 10-30-2002                        | Guangshun Yi et al.                                |   |                |
|                          | 8.                       | WO-91/09141   | 06-27-1991                        | Wang et al.  |   |                |

\*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

| NON PATENT LITERATURE DOCUMENTS |                          |   |                |  |
|---------------------------------|--------------------------|---|----------------|--|
| Examiner<br>Initials*           | Cite<br>No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T <sup>2</sup> |  |
|                                 | 9.                       | International Search Report for PCT/CN03/000666, mailed on October 10, 2003, 3 pages  |                |  |
|                                 | 10.                      | SANTRA et al., Anal. Chem. (2001) 73:4988-4993  |                |  |
|                                 | 11.                      | TAYLOR et al., Anal. Chem. (2000) 72:1979-1986  |                |  |

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

|                       |  |                    |  |
|-----------------------|--|--------------------|--|
| Examiner<br>Signature |  | Date<br>Considered |  |
|-----------------------|--|--------------------|--|

sd-302080